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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,186	03/23/2004	Erik Martz	525400-335	4647

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William Squire, Esq.  
c/o Carella, Byme, Bain, Gilfillan, Cecchi,  
Stewart & Olstein  
5 Becker Farm Road  
Roseland, NJ 07068

EXAMINER

SHAFFER, RICHARD R

ART UNIT PAPER NUMBER

3733

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/808,186	<b>Applicant(s)</b> MARTZ ET AL.	
	<b>Examiner</b> Richard R. Shaffer	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 21, 22-24, 26-73, 78-82 and 85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19, 20, 25, 74-77, 83 and 84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/3/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of Group I, Species 16 (Figure 76d-h), and Subspecies 28 (Figure 76d-h), readable by claims 19, 20, 23, 25, 27, 31, 33-39, 41-43, 45, 68-69, 74-77, and 80-84 in the reply filed on March 22<sup>nd</sup>, 2006 is acknowledged. The traversal is on the ground(s) that since generic claim 19 reads on Figures 1-6, 24-44, 45a-c, 66-79, 76a, 76d-q, and 80-104, that any claim directed to one of the other figures, but not the specific elected species also be included. This is not found persuasive because an election of species requirement means that the elected species is the specific one examined. **After prosecution is complete, should a claim be allowable which is readable on the elected species also read itself on other species, the species then may they be rejoined.**

Because of applicant's confusion of what a generic/linking claim was, applicant incorrectly included claims 23, 27, 31, 33-39, 41-43, 68-69, and 80-82 as readable upon Figure 76d which are dependent upon non-elected species according to the evidence supplied by applicant on March 22<sup>nd</sup>, 2006. They have thus been withdrawn by the examiner as being directed to a non-elected species.

Claims 1-18, 21, 22, 24, 26-73, 78-82, and 85 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 22<sup>nd</sup>, 2006.

The requirement is still deemed proper and is therefore made **FINAL**.

### ***Drawings***

The drawings are objected to because several drawings are supposedly additional views of the same figure; however they do not show the same features. For example, in Figures 76d-h, the opening (385) is not shown at all in Figures 76e,f, and h, and barely in 76g. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 83 and 84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "said walls" in line 5 of claim 83 makes the claim indefinite. It is unclear if applicant means both sets of walls (upper/lower and the two sides) or only one of the sets. Claim 84 is rejected for being dependent upon an indefinite base claim.

### ***Double Patenting***

Claims 74-77 and 83-84 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 and 56 of copending Application No. 10/520,794. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims of this application and the claims of the copending application lie in the fact that the copending application claims more elements and is thus more specific. Thus the invention as claimed in 1-48 and 56 of the copending application is in effect a "species" of the "generic" invention of claims 74-77 and 83-84. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20, 25, 74-77, 83, and 84 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (US Patent Application Publication 2002/0068941).

Hanson discloses:

**[First Interpretation]** a chisel (**Figure 6**) comprising: a shank (**103**); a cutting head (**106**) having the top surface extending parallel to the longitudinal axis of the shank and terminating with a cutting edge (**304**); a guide member (**102**) having side walls (**120**, **121**) extending in the direction of the shank and a distal end wall (**115**) transverse the longitudinal axis of the shank; the walls of the shank defining an central hollow opening (**112**) which extends through the cutting head; and the guide member having a second cutting edge (junction of **115b** and **115c**) which extends distally of the of the first cutting edge.

**[Second Interpretation]** a chisel (**10**, **Figure 2**) comprising: a bone cutting head (**26**) having opposing upper (**40**) and lower (**41**) walls defining a chamber, the walls are cantilevered (*Definition: A projecting structure, such as a beam, that is supported at one end and carries a load at the other end or along its length*) from a side wall of the shank (**17**) connected at a proximal end of the head, and the distal end of the walls ending in a first cutting edge (**23**); a pair of spaced (defining a space between and in communication with the head chamber) guide members (**20**, **21**) contiguous with and extending distally of the first cutting edge and terminating with second transverse edges (**20a**, **21a**).

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday during (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Shaffer  
April 10<sup>th</sup>, 2006



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER